

believes, the assignee of the above-identified application has not yet been able to locate and/or communicate with the other seven joint applicants concerning this Declaration and its subject matter.

2. A Statement Concerning Common Ownership by the undersigned attorney of record.

3. A Terminal Disclaimer with respect to U.S. patent No. 5,882,493.

4. A Terminal Disclaimer with respect to U.S. patent No. 6,652,806.

***Rejection under 35 U.S.C. §102(e)***

Claim 33, the only claim in the present application, has been rejected under 35 U.S.C. §102(e) as anticipated by the disclosure of U.S. patent No. 5,882,493 (Iwasaki et al. '493). In response, applicants submit that (1) insofar as pertinent, the disclosure of Iwasaki et al. '493 is a disclosure of subject matter conceived by and derived from the present applicants; (2) the disclosure of Iwasaki et al. '493 does not in fact anticipate present claim 33; and (3) Iwasaki et al. '493 is inapplicable as a reference under 35 U.S.C. §103(a) against claim 33 because the present invention and Iwasaki et al. '493 were, at the time the invention of present claim 33 was made, owned by, or subject to an obligation of assignment to, Ricoh Company, Ltd.

*Derivation*

The attached Declaration of the joint applicant Yukio Ide under 37 C.F.R. §1.132 is submitted as evidence that the eight joint applicants named in the present application (Yukio Ide, Hiroko Iwasaki, Yoshiyuki Kageyama, Yujiro Kaneko, Katsuyuki Yamada, Michiaki Shinotsuka, Makoto Harigaya and Hiroshi Deguchi)

jointly conceived the method of producing sputtering targets having the following specific compositions A and B:

	<u>A (atomic%)</u>	<u>B (atomic%)</u>
Ag	4.0	7.0
In	15.0	11.0
Te	25.0	22.0
Sb	56.0	60.0

by performing steps of mixing Ag, In and Te, heating the obtained mixture to a temperature above 600° so that the mixture is fused, rapidly cooling the substances of the mixture so that the resulting substances contain a chalcopyrite of AgInTe<sub>2</sub>, grinding the substances into particles, mixing the particles with Ag, In and Te with a simple substance of Sb, and sintering the mixture; and that, insofar as that subject matter is suggested or described in Examples 1 and 3 in Table 1A at col. 9 of Iwasaki et al. '493 (in conjunction with the disclosure e.g. at col. 4, lines 50-60, of Iwasaki et al. '493), it was originally conceived by the aforesaid eight joint applicants of the present application and the description thereof in Iwasaki et al. '493 is a description of subject matter that they conceived.

An uncontroverted, unequivocal statement from the applicant regarding the subject matter disclosed in a patent will be accepted as establishing inventorship. M.P.E.P. §716.10, and cases there cited. Neither the Manual nor the cited authorities address the situation where (as here) less than all of joint applicants can be located to join in such a statement. Nevertheless, the attached Declaration of the joint applicant Yukio Ide is uncontroverted and unequivocal. It is submitted that this Declaration establishes that the disclosure of Iwasaki et al. '493 insofar as pertinent to present claim 33 is a publication of the present joint applicants' invention and that the rejection of claim 33 on Iwasaki et al. '493 is thereby overcome.

### Anticipation

In rejecting present claim 3 under §102(e) as anticipated by Iwasaki et al. '493, the Office Action cites the abstract and the passage at col. 4, lines 50-70 (actually, lines 50-60), as teaching all the steps of the method of present claim 33. These portions of the patent are directed to compositional ranges which, though broadly overlapping, are not identical to the ranges recited in claim 33; therefore, they do not anticipate claim 33 under §102(e), but at most might be deemed to render claim 33 *prima facie* obvious under §103(a). *In re Peterson*, 65 U.S.P.Q.2d 1379 (Fed. Cir. 2003).

Recognizing this, the Examiner relies on Examples 1 and 3 in table 1A of Iwasaki et al. '493 as teaching the claimed composition. The patent, however, describes at least two alternative method step sequences for producing an AgInTeSb sputtering target: a first in which Ag, In and Te are initially mixed, fused, solidified and ground and only thereafter mixed with Sb (col. 4, lines 50-60), and a second in which Sb is mixed with Ag, In and Te at the outset (col. 4, line 63 - col. 5, line 5). The description of the Examples in the patent (col. 7, line 61 - col. 10, line 45) is not seen to specify which of these two methods was employed to produce the particular sputtering targets of Examples 1 and 3; hence Iwasaki et al. contains no actual *teaching* of performing the first method step sequence to produce sputtering targets having the compositions of those targets, regardless of whether such might be said to be *obvious* from its disclosure. Present claim 33, on the other hand, is expressly limited to a method step sequence corresponding to the first method step sequence of Iwasaki et al. '493 (as opposed to the second method step sequence of the patent). Therefore, it is submitted that Iwasaki et al. does not anticipate claim 33 under §102(e) but at most renders the subject matter of that claim *prima facie* obvious under §103(a).

*Common Ownership*

Iwasaki et al. '493, and the present application, were commonly owned or under an obligation of assignment to the same owner at the time the invention of present claim 33 was made, as evidenced by the attached Statement Concerning Common Ownership. It is submitted that Iwasaki et al. '493 (which is not an anticipation reference under §102(e), for the reason explained above) is thereby overcome as a reference under §103(a). 35 U.S.C. §103(c); M.P.E.P. §706.02(1)(2).

***Obviousness-Type Double Patenting***

In response to the rejection of claim 33 for obviousness-type double patenting over commonly owned U.S. patents Nos. 5,882,493 and 6,652,806, applicants are submitting herewith terminal disclaimers with respect to each of those patents. These terminal disclaimers are submitted to overcome both of the obviousness-type double patenting rejections.

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For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

*Christopher C. Dunham*  
Christopher C. Dunham  
Reg. No. 22,031  
Attorney for Applicants  
Tel. (212) 278-0400

I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

*Christopher C. Dunham*  
Christopher C. Dunham, Reg. No. 22,031

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